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APPLICATION NO. 07/311,837	FILING DATE 06/14/99	BARTA	FIRST NAMED INVENTOR T	ATTORNEY DOCKET NO.
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HM12/0614

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CHANG, EXAMINER

APR UNIT	PAPER NUMBER
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06/14/00

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/311,837

Applicant(s)

Barta et al.

Examiner

Cella Chang

Group Art Unit

1625



☒ Responsive to communication(s) filed on Jun 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-146 is/are pending in the application.

Of the above, claim(s) 1-6, 34, 43-51, 86, 95-127, and 132-146 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 7-33, 35-42, 52-85, 87-92, 94, and 128-131 is/are rejected.

☒ Claim(s) 93 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1625

### DETAILED ACTION

1. Applicant's election of Group II, claims 93-94 in Paper No. 6, dated Jun. 5, 2000, without traverse, is acknowledged. Generic claims 41-42, 52-85, 87-92, 128-131 is prosecuted to the extend that one of X, Y, Z is O and the others are C,  $m+n+p=3$ , together with the method claims 7-33 and 35-40 to the same extend of the compounds limited to treating angiogenesis. Claims 1-6, 34, 43-51, 86, 95-127, 132-146 and the remaining subject matter of claims 41-42, 52-85, 87-92 128-131, 7-33 and 35-40 are with drawn from consideration.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 94, 41-42, 52-85, 87-92, 128-131, 7-33 and 35-40 are rejected under 35

U.S.C. 103(a) as being unpatentable over Bender et al. US 5,932,595.

Bender et al. '595 disclosed homologous compounds of the claims (see col. 5 lines 4-10, 30-49, 52-68, col. 6, lines 1-13). The difference between Bender et al. '595 compounds and the instant claims is the insertion of one methylene moiety between the ring and the side chain. The difference of one methylene linkage is considered a prima facie structural modification within the teaching of the prior art in absence of unexpected results. In re Ruddy 121 USPQ 427; Ex parte Gresham 121 USPQ 422; Ex parte Nathan 121 USPQ 349.

3. Claims 41-42, 52-85, 87-92, 128-131, 7-33 and 35-40 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over the national stage application of Venkatesan et al. WO 98/37877 (cited on 1449)

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It is noted that the WO 98/37877 patent has a US priority date prior to the provisional date of the instant parent applications. Venkatesan et al. disclosed the instantly claimed tetrahydropyranyl compounds generically. The species of examples 86, 96 and 99 under the generic guidance disclosed on pages 9-10 wherein R2 and R3 can optionally be piperidine or tetrahydropyranyl rendered the instant claims obvious.

4. Claims 94, 41-42, 52-85, 87-92, 128-131, 7-33 and 35-40 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over the national stage application of Venkatesan et al. WO 98/37877 in view of Bender et al. '595.

The rationale as delineated in section 3 is also applicable here. The difference between claim 94 and the prior art is the substitution of the phenoxy ring with a trifluoromethyl moiety. Trifluoromethyl is an alternative choice of substituent as disclosed in analogous art, see Bender et al. '595, col.6, line 63.

5. Claim 93 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The substituent trifluoromethylthio is neither anticipated nor rendered obvious by the art of record.


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

Jun. 13, 2000

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200 1625

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subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.

- VIII. Claims 105-127 and 132-144 being drawn to intermediates and process of making thereof, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction may be required.

The inventions are distinct, each from the other because:

Inventions of groups I-VIII are independent and patentably distinct products or intermediates. Each group of compounds differ in element, bonding arrangement and chemical properties to such an extend that a reference anticipating compounds of one group would not render compounds of another group obvious. Unpatentability of any one group of invention would not necessarily imply unpatentability of another group of invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the inventions or the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art the evidence or admission may be used in a rejection under 35 U.S.C. 102(a) of the



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## FAX COVER SHEET

**DATE:** May 1, 2000

**TO:** Edward P. Gamson

**FROM:** Examiner Chang, Art Unit 1625

**RE:** SN 09/311,837 Attorney's Docket MON-116.6

**TOTAL PAGE** (including cover page) 4

If transmission is incomplete please contact Examiner Chang at 703-308-4702.